

limited to the full name of the owner, mailing address, vehicle identification number, make and year of the vehicle, and

- d. computer processing the databases by matching of non-corresponding sequences to generate a working database of uninsured motorists to a pre-determined high degree of reliability in excess of 95 percent of matching drivers/vehicle/policy.

20. (amended) A method for identifying uninsured motorists comprising:

- a. inputting into a computer processor a database of available accurate, inaccurate, repetitive, complete, and incomplete information concerning insurance information from all insurance carriers within a geographical area of all in-force policies containing, but not limited to the name of the insured, their mailing addresses, driver's license numbers, dates of birth, policy numbers and effective dates, make of vehicle, year of vehicle, type of vehicle, and vehicle identification number,
- b. inputting into a computer processor a database of available accurate, inaccurate, repetitive, complete, and incomplete information concerning driver information from the motorist licensing division within a geographical area containing, but not limited to a driver's full name, their license number, address, date of birth,
- c. inputting into the computer processor a database of available accurate, inaccurate, repetitive, complete, and incomplete information concerning vehicle information for the division of motor vehicles within a geographical area containing, but not limited to the full name of the owner, their mailing address, vehicle identification number, make and year of the vehicle,
- d. computer processing the databases by matching of non-corresponding sequences to generate a working database of uninsured motorists to a pre-determined high degree of reliability in excess of 95 percent of matching drivers/vehicle/policy,
- e. computer processor sorting and matching the insurance, driver, and vehicle databases to produce and generate a working database of uninsured motorists.
- f. statistically sampling the working database by checking a random sample to insure

the statistical accuracy of the working database,

- g. generating lists of uninsured motorists,
- h. providing on line real time computer display access to authorized personnel of the working database of uninsured motorists,
- i. mailing notices requesting insurance verification to uninsured motorists and inputting and updating the working database with the uninsured motorists replies to the notices, and
- j. computer generating and transmitting trend report summaries of the status of uninsured motorists within a geographical area to concerned public and private agencies.

21. (amended) An apparatus for identifying uninsured motorists comprising:

- a. input means,
- b. storage means into which a database of
  - i. available accurate, inaccurate, repetitive, complete, and incomplete information concerning insurance information from all insurance carriers within a geographical area of all in-force policies containing, but not limited to the name of the insured, their mailing addresses, driver's license numbers, dates of birth, policy numbers and effective dates, make of vehicle, year of vehicle, type of vehicle, and vehicle identification number,
  - ii. available accurate, inaccurate, repetitive, complete, and incomplete information concerning driver information from the motorist licensing division within a geographical area containing, but not limited to the driver's full name, their license number, address, date of birth,
  - iii. available accurate, inaccurate, repetitive, complete, and incomplete information concerning vehicle information from the division of motor vehicles within a geographical area containing, but not limited to the full name of the owner, their mailing address, vehicle identification number,

- make and year of the vehicle,
- iv. a sorting and matching program to computer process the databases by matching of non-corresponding sequences to generate a working database of uninsured motorists to a pre-determined high degree of statistical reliability in excess of 95 per cent of matching drivers/vehicle/policy,
  - c. a computer processor operably associated with the input means and storage means to translate and generate lists of uninsured motorists within a geographical area, and
  - d. a display terminal operably associated with and activated by the computer processor unit to display lists of uninsured motorists.

Unmarked copies of the above claims are appended hereto.

#### REMARKS

Responsive to the Final Office Action mailed 12/4/2002, the foregoing Second Amendment is submitted in an attempt to avoid the necessity of an appeal. The above amended claims are supported by the specification and more particularly point out applicant's invention disclosed on page 2 of the Summary of the Invention specification wherein it was disclosed that all relevant data, whether complete, accurate, or repetitive is inputted for the vehicle insurance processing. As such, they add no new subject matter.

Applicant's revised Claims 12 through 22 covering an insurance verification method using all available data, whether complete, accurate, or repetitive eliminates the need for extensive personnel screening training and insures more than sufficient input to generate highly accurate automobile insurance verification lists. Applicant's employment of all available data, whether accurate or not to provide highly accurate lists of drivers having automobile insurance is counterintuitive to the problem being solved. It is not disclosed in the references cited by the Examiner. Nor is it disclosed in the knowledge of persons of ordinary skill in the art and is therefore novel. According to MPEP Section 2143.01, the prior art must suggest the desirability of the claimed invention.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Nothing in the Garrett (Patent No. 5,325,291 or May et al suggests applicant's method processing all available information, including inaccurate information. Nor is there anything in the rest of the automobile insurance verification art, which suggests applicant's approach; as a search of the PhD thesis Web site [www.uni.com](http://www.uni.com) for the period 1999 to the present produced no other references than those cited by the Examiner. Consequently, where the Examiner has not identified the level of ordinary skill in the art of a practitioner who would be aware of applicant's method, and a search of the PhD art fails to disclose applicant's method more particularly described in the above amended claims, no prima facie case of obvious has been established to reject the above claims. As such, the amended Claims are not suggested by the prior art and the 35 USC §103(a) obviousness rejection of Claims 12-22, as amended as being unpatentable over Garrett (U.S. Patent No. 5,325, 291 in class 705/4) in view of May et al (May, Jerrold H. "A hybrid system improves claims auditing at Blue Cross", Interfaces, Providence, November/December 1993), which most likely would be catalogued in class 705/2, should be withdrawn.

According to MPEP Section 2142,

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Garrett does not address or disclose entering data input, which includes repetitive, incomplete and inaccurate data. It therefore does not disclose or suggest applicant's computer processing method, which generates uninsured motorist and vehicle databases with in excess of 95% reliability. The Garret reference is a computer matching system, which assumes the accuracy of the inputted databases--generally provided by the state insurance policy numbers to be collected and included at the time of registration for subsequent matching. It is therefore subject to "garbage in/garbage out" types of errors. Conversely, applicant's system assumes the unreliability of all raw input data. Applicant's method inputs all relevant data from multiple sources, whether accurate or not, and incorporates multiple algorithms as part of the process to generate uninsured motorist and vehicle databases with in excess of 95% reliability. It therefore is a "garbage in/reliable data out" type of processing system of suitable reliability for law

enforcement field action.

The May Hybrid System for auditing Blue Cross health claims also does not disclose applicant's computer processing method used to generate uninsured motorist databases, which have in excess of 95% reliability. Nor is there anything in the May and Garrett references themselves, which suggest combining them in the manner suggested by the Examiner. The Examiner's suggested combination is in clear violation of *In re Sang-Su Lee*, No. 00-1158 decided January 18, 2002 by the US Court of Appeals for the Federal Circuit, requiring objective evidence that something in the references themselves suggests combining them in the manner proposed by the Examiner; citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The uninsured motor vehicle verification industry is not the same as the health insurance claims processing industry. Their databases are different and involve different statutes, technologies, insurance codes, processing sequences, reviews, and claims assessment. Therefore, these dissimilar references cannot be combined in the manner suggested by the Examiner where there is nothing in the references themselves, which suggests their combination. For example, the health industry medical review sequence of the data input as well as co-payment verification is missing in the motor vehicle insurance verification industry. Nor is there any health industry requirement to cross check vehicle information against drivers. Such dissimilar industry practices teach away from combining these dissimilar methodologies.

Nor do either the Garrett or May references disclose the percentage quantities of matching of 96 percent, quality of computer matches of 99 percent, and an overall system reliability uninsured motorist database of 95.8 reliability. The Examiner has thus failed to objectively support the rejection of renumbered Claims 12 through 22, as amended, and the rejection should be withdrawn.

The New York State Department of Motor Vehicles also fails to provide any of the deficiencies with references discussed above; particularly with respect to suggesting or requiring statistical sampling methods. Nor is there anything in the reference itself, which suggests combining it with Garrett and May. The rejection of claims 12 through 22, as amended, based on the Garrett/May and the New York State combination of references rejection should therefore also be withdrawn.

The rejection of Claims 12 through 22, as amended, in view of Johnston is also traversed. Nothing in these references themselves suggests combining them in the manner suggested by the

examiner. Nor does Johnston supply any of the statistical sampling methodology requirements of base claim 12, as amended. The real time access method of renumbered Claim 17 dependent on base claim 12 is therefore not suggested by the references.

Nor is the mailing verification method of renumbered Claim 18 dependent on the statistical sampling methodology required of base claim 12, as amended, suggested by the reference. Nor do the Garrett, May, or Johnston references disclose data being updated with input from motorists. The Examiner has therefore provided no support for the obviousness rejection of Claim 18, and therefore the rejection should be withdrawn.

The rejection of Claim 9 (renumbered Claim 20) is dependent upon base claim 12, which is not suggested by the Garrett, May, and Johnston references as discussed above. Therefore this rejection is also improper and should be withdrawn.

The rejection of Claim 10 (renumbered Claim 21) is traversed. The Examiner has cited no "means-plus-function" structure, which accomplishes the method steps to reject the claim. As Garrett, May, and Johnston do not provide these features, the rejection is improper and should be withdrawn.

The rejection of Claim 8 (renumbered Claim 19) dependent upon renumbered Claim 12, as amended, as being unpatentable over the combined teachings of Garrett and May and further in view of Bosco (U.S. Patent No. 5,191,522 is traversed. As discussed above, neither Garrett nor May disclose applicant's invention. Nor does Bosco et al. supply any of these deficiencies. The rejection of renumbered Claim 19 employed in combination with renumbered Claim 12, as amended, transmitting reports of uninsured motorists outside of a closed system is therefore not suggested by the references, and the rejection should be withdrawn. Further, the Examiner has cited nothing in the references themselves, which suggest improving the ease of distribution of the Garrett and May references.

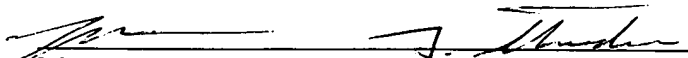
The rejection of Claim 11 (renumbered Claim 22) dependent upon amended Claim 21 as being unpatentable over the combined teachings of Garrett, May and Johnston as applied to Claim 10 (renumbered Claim 21) and further in view of Deppa (U.S. Patent No. 5,732,198) is similarly traversed. Garrett, May, and Johnston do not expressly disclose the configuration of renumbered Claim 22. Nor do they disclose electronic signal transfer of coded signals to a translator that converts the coded electronic signals into printed reports. Nothing in these references suggests combining the same with the Deppa to provide these deficiencies.

Therefore, the Examiner has improperly combined four references via hindsight reconstruction to reject renumbered Claim 22, as amended, and the rejection should be withdrawn where the Examiner has failed to identify exactly what prior art she is relying on as "ordinary skill" in the art which teaches the disputed features to enable applicant to respond thereto. Nor has the Examiner identified the level of skill in the art. Applicant is left guessing as to what is the basis for the rejection in paragraphs 4 and 6 on pages 9 and 10 of the Office action. Nor has the Examiner established how the industry practice treating health care claims processing as distinct from the automobile insurance verification industry as stated in paragraph 5 on page 10 of the Office Action can be arbitrarily ignored. Nothing in the references establishes that these methods are analogous. All insurance is not the same, but dependent upon contracts, industry specific probabilities and statutes and regulations. The Examiner has provided no support for her determination that these arts are analogous and therefore must accept the statements in the accompanying affidavit of Richard Kasteller in this regard. Mr. Kasteller has had years of experience in the automobile insurance verification industry and indicated on page 8 of his affidavit that the May health insurance claim procedure and the Garret motor vehicle verification involve different industries with different databases, insurance codes, processing sequences, reviews, and claims assessment and therefore are not analogous.

The rejection of Claims 12 through 22, as amended, should therefore be withdrawn. Applicant's invention and method provided the first statistically accurate uninsured motorist lists, which are reliable enough to be accessed in real time on line for field detention of uninsured motorists. It therefore meets the unexpectedly improved properties not present in the prior art under *In re Dillon*, 919 F.2d 692-93 (16 USPQ2d at 1901) to establish non-obviousness.

If the foregoing revised claims are not sufficient to allow said claims, a telephonic conference is requested with the Examiner.

Dated this 17<sup>th</sup> day of December 2002

  
Marcus G. Theodore, Attorney for Applicant  
Reg. No. 26,815  
466 South 500 East  
Salt Lake City, Utah 84102  
(801) 359-8622